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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/337,330	06/21/1999	JUHA MATTI PIRKOLA	017.37288X00	8862
43829	7590	09/01/2005	EXAMINER	
ROBERT M BAUER, ESQ. LACKENBACH SIEGEL, LLP 1 CHASE ROAD SCARSDALE, NY 10583			GELIN, JEAN ALLAND	
			ART UNIT	PAPER NUMBER
			2681	

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>2nd Supplemental Office Action Summary</b>	Application No.	Applicant(s)
	09/337,330	PIRKOLA ET AL.
Examiner	Art Unit	
	Jean A. Gelin	2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 31 January 2005.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-35 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-6, 9-12, 19, 20, 22-25, 29-35 is/are rejected.  
7)  Claim(s) 7,8,13-18,21 and 26-28 is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date .

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

## DETAILED ACTION

1. This is response to the Applicant's request over the telephone on August 04, 2005 to answer the applicant's arguments of the obviousness rejection filed on January 31, 2005.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 5, 6, 9, 10, 12, 19, 20, 22, 23, 25, and 29-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Egan et al. (US Pat. No. 6,560,223).

Regarding claims 1, 6, Egan teaches a method of allowing packet-switched telephony subscriber to roam within a packet switched telephony network (i.e., portable terminal using VoIP can roam from a home coverage to a remote coverage, col. 1, lines 22-65, col. 2, lines 25-35) comprising: sending a message from a subscriber terminal to a visited function in a packet switched telephony network, the message including a subscriber identification for the subscriber (i.e., the portable terminal roams to a visited remote coverage, typically the location update processes notify the portable's home coverage, col. 2, lines 25-35); the visited function sending a message to the subscriber's packet-switched telephony network home function providing a packet-switched

telephony network address of the visited function in the as updated subscriber location information and the subscriber identification (i.e., the remote site should send to home site information regarding the portable terminal for ID and the remote site for location, col. 2, lines 36-67); storing the network address of the visited function as location information for the subscriber (the home site typically stores information regarding the portable terminal and the remote site to keep track of its location, col. 3, lines ).

Regarding claim 2, Egan teaches receiving a call that is directed to the subscriber (col. 5, lines 1-15); obtaining the location information for the subscriber from the subscriber's Packet switched telephony network Home Function including the network address of the visited function (col. 5, lines 1-15); routing the call to the subscriber terminal by establishing a packet-switched telephony call towards the network address of the serving visited function (col. 5, lines 1-67).

Regarding claims 3, 9, 22, Egan teaches forwarding the call from the serving visited function to a subscriber terminal (col. 5, lines 10-42).

Regarding claim 5, Egan teaches the network address of the serving visited function comprises an Internet Protocol (IP) address (col. 1, lines 22-40, col. 6, lines 40-67).

Regarding claims 10, 23, Egan teaches forwarding the call from the visited function to the called subscriber includes the step of forwarding the call as a packet switched telephony call to the called subscriber (col. 7, line 61 to col. 8, line 9).

Regarding claims 12, 25, Egan teaches the remote system (i.e., visited function) is provided on the called subscriber terminal (col. 6, lines 41-67).

Regarding claim 19, Egan teaches a method of call delivery within a mobile Packet-switched telephony network comprising: receiving a local call at a gateway function, the call including a subscriber identification of the called subscriber (i.e. incoming call includes relevant information to set up a call, col. 6, lines 1158); the gateway function obtaining from the subscriber's packet-switched telephony home function subscriber location information for the called subscriber, the subscriber location information including an address of a visited function corresponding to the subscriber identification (col. 7, line 52 to col. 8, line 36); and establishing a packet-switched telephony call from the gateway function towards the address of the visited function (col. 8, lines 11-41).

Regarding claim 20, Egan teaches sending an address request message including the called subscriber's subscriber identification from the gateway function to the called subscriber's home function in the packet-switched telephony network (col. 7, line 60 to col. 8, line 10); the home function identifying subscriber location information including an address of a visited function corresponding to the subscriber identification (col. 8 lines 11-36); and receiving a message at the gateway function from the subscriber's home function including the address of the visited function corresponding to the subscriber identification (col. 7, line 60 to col. 8, line 36).

Regarding claim 29, Egan teaches packet-switched telephony network that supports mobility comprising: a home function including a home function database storing current location information and a subscriber profile for one or more subscribers (i.e., database is present to collect registration and where-about of the portable terminal,

col. 7, lines 11-28); and one or more visited functions, each visited function serving an area of the packet switched telephony network each visited function providing the visited function address to the home function in response to receiving a subscriber registration request, the home function storing the address of the visited function as updated subscriber location information (col. 3, line 44 to col. 4, line 15 and col. 7, line 52 to col. 8, line 35).

Regarding claim 30, Egan teaches a subscriber terminal coupled to a visited function, the subscriber terminal providing a update location message including a subscriber identification to the visited function (col. 7, lines 11-52).

Regarding claim 31, Egan teaches a subscriber terminal is coupled to the visited function via a wireline link (col. 4, lines 42-58).

Regarding claims 32, 33, Egan teaches a subscriber terminal is coupled to the visited function via a wireless link (col. 4, lines 42-58).

Regarding claim 34, Egan teaches a subscriber terminal is coupled to the visited function via a packet switched network (col. 6, line 60 to col. 7, line 9).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Egan et al. (US Pat. No. 6,560,223) in view of Alexander Jr. et al. (US Pat. No. 5,870,589).

Regarding claim 4, Egan teaches all the limitations above except the packet-switched telephony network address of the serving visited function comprises an Asynchronous Transfer Mode (ATM) address.

However, the preceding limitation is very well known in the art of communication as evidenced by Alexander. Alexander teaches the use of ATM protocol address to securely send packet data to correct destination (col. 8, lines 29-67). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the techniques of Alexander within the system Egan in order to provide fast packet switching and support multiple concurrent connections over a single communications lines.

6. Claims 11, 24, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egan et al. (US Pat. No. 6,560,223) in view of Kelly (US Pat. No. 6,347,085).

Regarding claims 11, 24, and 35, Egan teaches all the limitations above except the steps of translating the packet-switched telephony call received at the visited function to a format used by the subscriber terminal that is incompatible with packet-switched telephony; forwarding the translated call from the visited function to the called subscriber terminal.

However, the preceding limitations are very well known in the art of communications, as evidenced by Kelly. Kelly teaches a gateway apparatus for

connecting a circuit switched communication network to a packet switched data network comprises a processor for packetizing logic configured to translate data from the circuit switched communication network into a format suitable for transmission over the packet-switched data network to a terminal (col. 4, lines 55-66). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the techniques of Kelly within the system Egan in order to enable translation of a conventional telephone number from a client task on an IP-based network into a network protocol address representing a gateway.

***Allowable Subject Matter***

7. Claims 7-8, 13-18, 21, 26-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection.

The Applicant argues that claims 1-3, 5, 6, 9, 10, 12, 19, 20, 22, 23, 25, and 29-34 are not anticipated by Ahopelto. The Examiner withdraws the Ahopelto's reference, and applies Egan et al. to write the 103 rejection (see rejection above).

The Applicant further argues that claims 4, 11, 24, and 35 are not obvious because the motivation given to support the proposed narrow modification is not fairly

suggested by the secondary references. The rejections merely note that the missing features of the dependent claims are present in the embodiment of the secondary references, and apparently asserts that only these features would be taken from the secondary references and inserted into Ahopelto.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). however, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969). In this case, Egan and Alexander, Jr. are in the same field of endeavor, they both use the Internet network which is equivalent to a packet switched network (Egan, col. 1, lines 24-26) and it is known the ATM is packet-like switching according to Newton's dictionary. Given that Egan teaches packet switched telephony network (inherently present in the teaching of VoIP) and Alexander teaches the operation of Lan Emulation Resolution Protocol (LE\_ARP) request; in response to this request LES responds with the ATM protocol network address (besides col. 8, lines 29-67, the entire application explains the efficiency of using ATM). ATM address is inherently present in the system of Egan and Alexander as recited above.

Therefore, the Examiner maintains that the network comprises an ATM address is taught by Egan in view Alexander.

The Examiner also maintains the obviousness type rejection of Egan in view of Kelly. Both references teach communication over the packet switched network. Kelly teaches a gateway apparatus for connecting a circuit switched communication network to a packet switched data network comprises a processor for packetizing logic configured to translate data from the circuit switched communication network into a format suitable for transmission over the packet-switched data network to a terminal (i.e., equivalent to make information from one network to another compatible to each other, col. 4, lines 55-66). The Examiner maintains the rejection as recited above.

In light of the above arguments, the Examiner submits that all rejections above are maintained. Should the Applicant have any questions or comments regarding the above rejections, the Applicant is respectfully requested to address them in the response of this Office Action.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean A. Gelin whose telephone number is (571) 272-7842. The examiner can normally be reached on 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**JEAN GELIN  
PRIMARY EXAMINER**

JGelin  
August 29, 2005

*Jean Alland Gelin*